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PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: David R. Tushie et al. Examiner: Mary Cheung  
Serial No.: 09/416,252 Group Art Unit: 3621  
Filed: October 12, 1999 Docket No: 457.003US3  
Title: SYSTEM AND APPARATUS FOR SMART CARD PERSONALIZATION

**RESPONSE TO RESTRICTION REQUIREMENT**

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

In response to the Restriction Requirement mailed January 11, 2005, Applicant elects, with traverse, Group I (claims 25-34). The Examiner is invited to contact Applicant's Representative if there are any questions regarding this Response or if prosecution of this application may be assisted thereby.

**Traversal**

The Restriction Requirement is traversed on the basis that it fails to meet the two criteria for a proper requirement for restriction between patentably distinct inventions. M.P.E.P. § 803 states that the two criteria for restriction between patentably distinct inventions are:

- (A) The inventions must be independent or distinct as claimed; and
- (B) There must be a serious burden on the examiner if restriction is required.

***The Inventions Must Be Independent Or Distinct As Claimed.*** The restriction required is between four claimed subcombinations. As noted on page 2 of the Office Action, the embodiments of the invention in the four claimed subcombinations are usable together in a single disclosed combination. The disclosed combination includes various systems and methods for producing portable programmed data carriers.

It is respectfully submitted that the four subcombinations identified by the Restriction Requirement have not been shown to be separately usable and, as a result, are not distinct from each other. The M.P.E.P. states:

The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination. . .The burden is on the examiner to provide an example. (*MPEP § 806.5(d)*).

The Restriction Requirement has not identified examples that prove that each of the subcombinations are distinct from each other. Rather, the examples provided for each group could be applied to any of the groups, and further, in most instances each example cited in the Office Action is recited in one or more claims from one or more of the other groups.

**Group I.** The Restriction Requirement states that Group I (claims 25-34) is "drawn to translating the internal script," and that the claims have separate utility "such as translating the internal script." However, embodiments of the invention as claimed in Groups II-IV either recite, have utility in, or both recite and have utility in translating the internal script.

For example, Group II includes independent claim 35 reciting, "interpreting cardholder data into a internal format if it is not in the internal format," and further "creating a plurality of program commands for a particular personalization equipment." (emphasis added) In another example, Group III includes independent claim 38 reciting, "to interpret the script into the program commands using the smart card definition." (emphasis added) In a further example, Group IV includes independent claim 42 reciting, "a smart card framework data structure comprising," wherein the Applicant's specification states, "The system 100 then uses the information contained in the card framework template and data format template to set up an internal 'script,' which it later interprets into the specific commands contained in the card operating system and personalization equipment records that instruct the personalization equipment to process the personalization data and issue the card for each cardholder." (*Applicant's Specification*, Page 26, Lines 26-30; emphasis added) Hence, a smart card framework data structure has utility in translating a script. For at least the reasons stated above, Group I is not distinct from Groups II, III, and IV as suggested by the Office Action.

**Group II.** The Restriction Requirement states that Group II (claims 35-37) is "drawn to determining an internal format and mapping the internal format," and that the claims have separate utility "such as determining an internal format." However, embodiments of the

invention as claimed in Groups I and III-IV either recite, have utility in, or both recite and have utility in determining an internal format and mapping the internal format.

For example, Group I includes independent claim 25 reciting, "creating instructions for an internal script from the personalization data." In another example, Group III includes independent claim 38 reciting, "and further causes the processing unit to map the cardholder data into data fields specified by the card application definition to create a script." In a further example, Group IV includes independent claim 42 reciting, "a smart card framework data structure comprising," wherein the Applicant's specification states, "As each personalization data record 952 is passed at block 1015, the smart card personalization system 100 uses the data format template, if present, to translate the personalization data into an internal format, and the card application data and card framework template to map the personalization data into variables in a command script written in an internal scripting language at block 1017." (*Applicant's Specification*, Page 24, Lines 9-13) Hence, a smart card framework data structure has utility in determining an internal format and mapping the internal format. For at least the reasons stated above, Group II is not distinct from Groups I, III, and IV as suggested by the Office Action.

**Group III.** The Office Action on page 2 with regards to Group III states, "Claims 38-41, drawn to acquiring information from a smart card." (emphasis added) Applicant disagrees. Independent claim 38 recites, "wherein the smart card personalization system causes the processing unit to acquire a smart card definition, a card application definition, program commands for a particular personalization equipment, and cardholder data." Nowhere in the recitation in claims 38-41 is the acquisition of "information" limited to acquisition from a smart card, as alleged in the Office Action. Applicant's specification discloses several embodiments that acquire data from sources other than a smart card. For example, "The smart card personalization system issues portable programmed data carriers, or smart cards, by first acquiring a data format identifier, a card operating system identifier, a personalization equipment identifier, an application program identifier or identifiers, and personalization data for a cardholder from a card issuer management system." (*Applicant's Specification*, Page 3, Lines 22-26; emphasis added) Thus, the Office Action has grouped claims 38-41 according to a limitation

which does not necessarily limit the claims. Therefore, the Office Action fails to state any grounds upon which the grouping of claims 38-41 might be properly made.

Even assuming *arguendo* that claims 38-41 are not improperly grouped, the Restriction Requirement still fails to identify any example for claims 38-41 that prove they are distinct from Groups I-II and IV as suggested in the Office Action.

The Restriction Requirement states that Group III (claims 38-41) has utility "such as acquiring a smart card definition." However, embodiments of the invention as claimed in any one of the claims 25-44 are usable for acquiring a smart card definition. Embodiments of the invention as claimed in claims 25-44 relate generally to producing portable programmed data carriers. In some embodiments, acquiring a smart card definition is included as a part of the process of producing portable programmable data carriers. As stated in the Applicant's specification, "Because each card issuer formats its personalization data differently and may have multiple data formats, the smart card personalization system has a database of data format templates that enable it to interface with multiple card issuer management systems. The system acquires the format template defining the personalization data used by a particular card issuer from a record in the database identified by the data format identifier." (*Applicant's Specification*, Page 3, Line 28 through Page 4, Line 4) Thus, Group III is not distinct from Groups I, II, and IV as suggested in the Office Action. The subcombinations as claimed in all of Groups I-IV are usable for acquiring a smart card definition.

**Group IV.** The Restriction Requirement states that Group IV (claims 42-44) is "drawn to plurality of fields contain information are stored on a smart card," and that the claims have separate utility "such as plurality of fields contain information are stored on a smart card." However, embodiments of the invention as claimed in Groups I-III either recite, have utility in, or both recite and have utility in a plurality of fields containing information stored on a smart card.

For example, Group I includes independent claim 25 reciting, "acquiring personalization data for a cardholder." The Applicant's specification states, "The chip in a smart card is programmed with initialization and/or personalization data." (*Applicant's Specification*, Page 1, Lines 23-24) Further, "The data format template record 1200 defines an hypothetical layout of

the personalization data records in the cardholder database 952 in which the account number 1201 is the first field, the cardholder's name 1202 is the second field, and the expiration date of the card 1205 is the third field." (*Applicant's Specification*, Page 22, Lines 14-18; emphasis added) Thus, in some embodiments, personalization data that is to be stored on a smart card is comprised of a plurality of fields. Therefore, the claims in Group I have utility in a plurality of fields containing information stored on smart cards.

Further, the Applicant's specification states, "Smart cards are also programmed with information specific to an individual cardholder through a process called 'personalization'." (*Applicant's Specification*, Page 2, Lines 8-9; emphasis added) In another example, Group II includes independent claim 35 reciting, "mapping the internal format of the cardholder data into a plurality of data fields used by a card application." (emphasis added) In still another example, Group III includes independent claim 38 reciting, "and further causes the processing unit to map the cardholder data into data fields specified by the card application definition to create a script." (emphasis added) As noted above, cardholder data is data to be stored on portable programmed data carriers, more commonly called "smart cards." For at least the reasons stated above, Group IV is not distinct from Groups I, II, and III as suggested in the Office Action.

***There Must Be A Serious Burden On The Examiner If Restriction Is Required.***

MPEP § 803 states: "If a search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Claims 25-44 are drawn to systems and methods of producing portable programmed data carriers, and can be efficiently and effectively searched concurrently without serious burden to the Examiner. Further, since multiple Office Actions have already been prosecuted with regards to this application, a search and examination of this application has already been performed. This is especially true in light of the fact that no amendments were made to the claims in the filed response to the previous Office Action. Thus, Applicant respectfully requests that the Examiner withdraw the Restriction Requirement and proceed with the examination of the application on the merits.

*Provisional Election*

The Office Action fails to meet the two criteria for a proper requirement for restriction between patentably distinct inventions. As stated above, the Office Action has failed to show the subcombinations are distinct from each other. Also as stated above, the entire application can be examined without serious burden on the Examiner. However, Applicant provisionally elects, with traverse, the claims directed to Group I (claims 25-34).

*Information Disclosure Statement*

Applicant is submitting an information disclosure statement herewith. Applicant respectfully requests that the Examiner consider the references provided with the accompanying Information Disclosure Statement and that an initialed copy of the Form 1449 be returned with the next official communication.

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**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6970 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully Submitted,

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By their Representatives,

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Date

Feb 11, 2005

By

  
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CERTIFICATE UNDER 37 CFR § 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelop addressed to: MS. Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 11 day of February 2005.

Name

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Signature

